

## **REMARKS/ARGUMENTS**

### **I. Concerning the Amendments**

The specification is amended at page 6 to correct a clear typographical error relating to the units used to express dry coatweight. Dry coatweight is expressed using the units g/m<sup>2</sup> throughout the remainder of the specification and the claims.

Claim 1 is amended to include the velocity limitation of Claim 28, and Claim 28 is cancelled. This amendment is presented in view of the fact that the references cited in numbered paragraph 17 of the Office Action dated September 7, 2005, do not teach or suggest such a velocity.

### **II. Concerning the Rejections over Prior Art**

As stated on the first page of the present application, this application is a c-i-p of U.S. Application No. 10/273,922, filed October 17, 2002, which is a c-i-p of U.S. Application No. 10/257,172, filed April 12, 2002. Note that U.S. Application No. 10/257,172 is a 371 of PCT/US02/12002, filed April 12, 2002 (published on October 24, 2002 as WO 02/084029 (hereinafter Urscheler '029)), which claims priority to EP 01109266.5 filed April 14, 2001 (published on October 16, 2002 as EP 1 249 533 A1 (hereinafter Urscheler '533)).

#### **Urscheler '533**

All claims stand rejected as being obvious over Urscheler '533 in combination with various secondary references. Applicants are well aware of the Urscheler '533 reference, since it lists one of the present applicants, Robert Urscheler, as sole inventor. The present application is related to Urscheler '533 as described in the preceding paragraph.

As explained in the previously filed response, Applicants believe that Urscheler '533 is not a reference under any section of 35 USC 102.

Applicants previously asserted that Urscheler '533 is not a reference under 35 USC 102(a) since Urscheler was not published before the invention of the present application was invented. As specified in a previously filed declaration under 37 CFR 1.131, the inventors of the present application were in possession of,

and had reduced to practice, the present invention prior to October 16, 2002, as evidenced by the filing on October 15, 2002 of the application that later published as WO 2004/035929 A1. Examiner criticizes the 131 declaration for two reasons: (1) that Applicants did not indicate that the reduction to practice occurred in this country; and (2) that Applicants did not indicate in the 131 declaration that WO 2004/035929 A1 is identical to what was filed on October 15, 2002. Regarding point (1), Applicants note that in paragraph 4) of their 131 declaration they state that the filing of October 15, 2002 was made in the US Receiving Office. The filing in the US Receiving Office is a reduction to practice in this country. Thus, by stating that the filing occurred in the US Receiving Office, Applicants indicated that the relevant application/invention was reduced to practice in this country.

Regarding point (2), the application that later published as WO 2004/035929 A1 was filed in the US Receiving Office and both the filed application as well as WO 2004/035929 A1 are believed to be publicly available records. Nevertheless, as stated in the enclosed declaration of Joyce E. Clark, based upon a comparison of both documents, the as-filed text of the application that later published as WO 2004/035929 A1 is identical to the text of WO 2004/035929 A1.

In view of the fact that Urscheler '533 is not a reference, reconsideration of all pending rejections under 35 USC 103 is respectfully requested.

Even if, for the sake of argument, the preceding argument is not accepted, it must be considered that Urscheler '533 is in the family of the present application. Accordingly, any disclosure of Urscheler '533 that is also found in the present application is not available as prior art. Applicants respectfully submit that the remaining, reduced, disclosure of Urscheler '533 is so limited that it does not support a prima facie case of obviousness when taken in combination with the secondary references.

Urscheler '029

All claims stand rejected as being obvious over Urscheler '029 (as prior art under 35 USC 102(e)) in combination with various secondary references. Applicants are well aware of the Urscheler '029 reference, since it lists one of the present applicants, Robert Urscheler, as sole inventor. Urscheler '029 is a WO

publication which claims priority from the European application which published as Urscheler '533. The present application is related to Urscheler '533 and Urscheler '029 as described hereinabove.

The present application and the application published as Urscheler '029 were, at the time the invention of the present application was made, subject to an obligation of assignment to the same person. Accordingly, since Urscheler '029 is only available as prior art under 35 USC 102(e), 35 USC 103(c) provides that Urscheler '029 is not available as a reference under 35 USC 103.

Furthermore, Urscheler '029 is in the family of the present application. Accordingly, any disclosure of Urscheler '029 that is also found in the present application is not available as prior art. Applicants respectfully submit that the remaining, reduced, disclosure of Urscheler '029 is so limited that it does not, in combination with the secondary references, support a prima facie case of obviousness.

Tetra Laval in view of Wittosch et al.

All claims stand rejected as being obvious over WO 01/54828 (hereinafter Tetra Laval) in combination with Wittosch et al. (hereinafter Wittosch), with the rejections of certain claims using additional secondary references. Applicants note that Wittosch is not a reference under 35 USC 102(b), but may be a reference under other statutory provisions.

Applicants respectfully submit that neither Tetra Laval nor Wittosch contain any teaching that would motivate one of ordinary skill in the art to combine their teachings. While both references fall within the general field of paper coating, they are disconnected references that do not provide the skilled artisan any motivation to combine their teachings. For example, Wittosch is directed to the production of recyclable and repulpable coated paper stock, preferably for use as ream wrap. Tetra Laval is directed to a multi-layer packaging laminate. Nothing in the references would motivate one of ordinary skill in the art to combine their teachings.

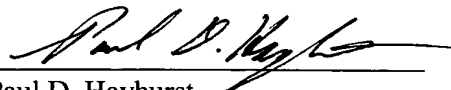
Even if, hypothetically speaking, the references could be combined, the combination of Tetra Laval and Wittosch does not support a prima facie case of obviousness. All claims now require that the moving web have a velocity of at least 200 m/min. Both Tetra Laval and Wittosch are silent in this regard.

Accordingly, Applicants submit that the references do not support a prima facie case of obviousness. Reconsideration of the rejection under 35 USC 103 is respectfully requested.

IV. Conclusion

Reconsideration of the claims and passing of the application to allowance are solicited.

Respectfully submitted,



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